



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/851,628 05/06/97 COHEN

C CRP-145

EXAMINER

HM12/1213

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ROMEN, D

ART UNIT

PAPER NUMBER

1646

15

DATE MAILED:

12/13/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**Application No.  
**08/851,628**Applicant(s)  
**Cohen et al.**Examiner  
**David S. Romeo**Group Art Unit  
**1646****THE PERIOD FOR RESPONSE:** [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on 12 Nov 1999 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on 12 Nov 1999 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

- ☒ will not be entered because:

- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Claims 3 and 12 recited limitations that were not previously examined, and such limitations require further consideration and/or search.

- ☒ Applicant's response has overcome the following rejection(s):

See the Attachment.

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See the attachment.

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: none

Claims rejected: 1-4, 6-10, 12-17, 24, 28, and 32

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

*David Romeo*  
**DAVID ROMEO**  
**PATENT EXAMINER**

Art Unit: 1646

**Attachment to Paper No. 15 (Advisory Action)**

1. Applicants' response would have overcome the following rejection(s) if the proposed amendments had been entered:

a. The rejection of claim(s) 3, 4, and 12 under 35 U.S.C. § 112, second paragraph.

2. The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: Applicants' arguments have been fully considered but they are not persuasive. The examiner's arguments regarding suggestion, motivation, and reasonable expectation of success are of record. See the last Office action mailed 5/12/99 (Paper No. 10) at pages 3-4. Furthermore, the claims are not limited to treating chronic renal failure caused by non-immune, non-inflammatory conditions. All that the claims require is administering an OP/BMP renal therapeutic agent to mammal in, or at risk of, chronic renal failure, which the prior art provides. As long as a mammal is in, or at risk of, chronic renal failure it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to administer OP-1 no matter what afflicts the mammal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Romeo whose telephone number is (703) 305-4050. The examiner can normally be reached on Monday through Friday from 6:45 a.m. to 3:15 p.m.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.  
Official papers filed by fax should be directed to (703) 308-4242.  
Faxed draft or informal communications should be directed to the examiner at (703) 308-0294.  
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*David S. Romeo*  
**DAVID ROMEO**  
**PATENT EXAMINER**  
December 6, 1999